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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,224	02/15/2001	J. David Martin	BHAM-01001US0 SRM/KFK	2546
23910	7590	12/19/2005	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/784,224	MARTIN, J. DAVID	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's amendment of 9/26/05 has been entered. Currently claims 10-43 are pending. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 26-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 26, applicant has added language to the claim and has recited a step of receiving data at a system that has a server, then applicant recites communication links and agreements. The communication links and agreements recitations are unclear because it is not clear if this is just a recitation to structure of the system or if this is a recitation to some kind of method step. The claim reads fine up to "as provided by a vendor of said design elements" but then the claim continues with "communication links", and has no language like "wherein said system further comprises" or "the method further comprises". This adds confusion to the claim as to what is being claimed, structure or a method step?

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11-24,26,27,31-43, are rejected under 35 U.S.C. 102(b) as being anticipated by Fino et al. (5689705).

For claims 35,39,41, Fino discloses a system and method for allowing a potential purchaser of a home (anybody) to review building designs and create a customized home by choosing from various building options. Fino discloses a computer/server 25 with a communication device 24. The claimed design device is the Options Module of Fino that allows options to be selected by the user of the system. The user interface device is the monitor/display of the computer/server 25. The user interface is the software/programming that creates the various screens shown in the figures. This allows for the selection, arrangement, and design as claimed. The ordering mechanism is the Contract Module of Fino. For claim 35, with respect to the recitation to “agreements”, an agreement is not a real world tangible thing and the examiner does not consider this to be a recitation to any structure of the system. The claim is not reciting that there are agreements stored (which is just data anyway) but is reciting the agreements as a structural part of the system, which they are not. With respect to the language reciting that a particular design element can be provided by multiple vendors, this is a functional recitation that adds no further structure to the system because it defines nothing to the system. The prior art is fully capable of what has been claimed.

For claim 36, Fino discloses manufactured homes as claimed. With respect to the recitations about the ordering mechanism, they are method limitations directed to the intended manner of use for the system and do not define any kind of structure that is not found in Fino; therefore, Fino anticipates what is claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

For claim 37, Fino discloses a Finance Module that communicates with the user and can calculate the buying power of the user as claimed.

For claim 38, Fino discloses the user interface as being an application stored on a computer as claimed. As best understood by the examiner, Fino discloses the claimed type of communications device because Fino discloses a server 25. The examiner does not consider the name of the server to be reciting any specific type of structure, because the claimed hypertext transfer protocol is not a structural element of the system but rather is the programming language used for the transfer of data.

For claim 40, Fino discloses various screens for the display of data. Screens are pages as claimed. The examiner does not consider the name of the page to be reciting any specific type of structure, because the claimed page is not even a structural

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element of the system but rather is an intangible thing (a collection of data to be displayed).

For claim 42, the design features (type of data saved) are considered to be non-functional descriptive material that does not serve as a limitation. *In re Gulack*, 217 USPQ 401 (CAFC 1983). However, Fino discloses the cost associated with the features. As an example, see figure 3B. Fino also clearly shows availability of features. If they are available you can see them, if not then they are not shown.

For claim 43, this is another method limitation and is satisfied by the fact that the features are present in the system of Fino. The options data had to get entered somehow and a person (a vendor) was responsible for them being saved on the server 25.

For claims 10,11,35, Fino discloses a system as claimed. Fino discloses a system and method for allowing a potential purchaser of a home (anybody) to review building designs and create a customized home by choosing from various building options. The database processor is the server 25. The user interface is the software/programming that creates the various screens shown in the figures. The communication links are the networking of computers between regional offices, sales offices, corporate offices, and design centers that allows transfer of any kind of data (sales, buyer data, homes data, etc.). This allows data to be sent between more than one other entity (not just between two computers) and this satisfies what has been claimed with respect to the communication links. See column 7, lines 5-55. The central server is the computer of any one of the offices that are networked together. The

recitation of what the entries in the database are comprised of are non-functional descriptive material that does not serve as a limitation (*In re Gulack*, 217 USPQ 401 (CAFC 1983)), but is satisfied by the fact that design options for homes are available for review by a user of a system. With respect to the recitation to "agreements", an agreement is not a real world tangible thing and the examiner does not consider this to be a recitation to any structure of the system. The claim is not reciting that there are agreements stored (which is just data anyway) but is reciting the agreements as a structural part of the system, which they are not. With respect to the language reciting that a particular design element can be provided by multiple vendors, this is a functional recitation that adds no further structure to the system because it defines nothing to the system. The prior art is fully capable of what has been claimed.

For claim 12, the examiner considers the server of Fino to be a Web server. A server is a server and the term "Web" lends no further structure to the term "server". Fino discloses various screens for the display of data. Screens are pages as claimed. The examiner does not consider the name of the page to be reciting any specific type of structure, because the claimed page is not even a structural element of the system but rather is an intangible thing (a collection of data to be displayed).

For claims 13,14, for the system to be able to transfer data to and from the various offices discussed in column 7, some kind of data transfer protocol is required. The term "Internet transfer protocol" is considered satisfied by Fino. The Internet is simply a bunch of connected computers and this is what Fino discloses. This is also a

recitation directed to the type programming language used for the transfer of data, which is not a structural limitation, but rather is an intangible thing.

For claims 15,20,21, this claim is directed to the method of use for the system where Fino is fully capable of operating as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

For claims 16-18, Fino discloses a manufacturer of homes. A manufacturer of homes is a building component manufacturer, a property lot developer, and a building element designer as claimed. These names define nothing to the system of claim 10 and are satisfied by Fino.

For claim 19, the order processor is the Contract Module of Fino and operates as claimed.

For claim 22, the claimed finance processor is considered to be the Finance Module of Fino.

For claim 23, Fino discloses a method as claimed. With respect to the recited providing of a system, see the discussion for claims 10 and 35 where these limitations are discussed. Fino discloses a system as claimed. A user can select from options

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(features) as claimed by using the Options Module. The inputs are made via a user interface (computer). A home manufacturer is inherently selected as claimed because you are reviewing home models of a manufacturer. With respect to the selecting of a contractor to prepare a site for placement of the home, this is inherently done. A contractor must be selected to make the foundation for the home at some point in the process so that the home can then be built. The ordering of parts and labor to construct the home is also inherently part of the process. With respect to the recitation to "agreements", an agreement is not a real world tangible thing and the examiner does not consider this to be a recitation to any structure of the system, which is the way it has been claimed. Applicant has claimed an agreement and the examiner notes that this is not a method step of creating any kind of agreement with vendors but is claimed as part of the system. The claim is not reciting that there are agreements stored (which is just data anyway) but is reciting the agreements as a structural part of the system, which they are not. With respect to the language reciting that a particular design element can be provided by multiple vendors, this is a functional recitation that adds no further structure to the system because it defines nothing to the system. Method step wise, the prior art is fully capable of what has been claimed because a vendor can provide design elements are claimed.

For claim 24, Fino discloses that the buying power of the purchaser can be calculated. See the disclosure relating to the Finance Module that performs this method step.

For claim 26, Fino discloses the claimed method. With respect to the recited providing of a system, see the discussion for claims 10 and 35 where these limitations are discussed. Fino discloses a system as claimed. Fino discloses that building layouts and available features are saved and selectable by a potential home purchaser. This is the done in the Options Module and the Plan Selection Module of Fino. The database must be updated as claimed so that the features and plan layouts can be stored. The user then selects the layout they desire and any options they desire. The chosen options are preferred options. With respect to the apparent structural recitation to “agreements”, an agreement is not a real world tangible thing and the examiner does not consider this to be a recitation to any structure of the system, which is the way it has been claimed. Applicant has claimed an agreement and the examiner notes that this is not a method step of creating any kind of agreement with vendors but is claimed as part of the system. The claim is not reciting that there are agreements stored (which is just data anyway) but appear to be reciting the agreements as a structural part of the system, which they are not because they are not a tangible thing that could constitute structure to a system. With respect to the language reciting that a particular design element can be provided by multiple vendors, this is a functional recitation that adds no further structure to the system because it defines nothing to the system. Method step wise, the prior art is fully capable of what has been claimed because a vendor can provide design elements are claimed.

For claim 27, see figures 2A-2E, which show the displaying of a drafted design.

For claim 31-33, it is disclosed that the Contract Module can print a contract. A contract is an order to construct the building. The order is then sent to a vendor (the builder).

For claim 34, see column 6, lines 15-24 where the claimed limitation is disclosed.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 25,28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fino et al. (5689705) in view of Barad et al. (6206750). Fino discloses the invention substantially as claimed.

For claims 25,28-30, Fino does not disclose that the step of receiving inputs is done by the use of a Web site and a HTTP server. Fino discloses the use of a computer/server that may be networked to other offices and their computers for the selection of home designs and options. Fino does not disclose that the reviewing of home layouts and selection of features/options is done by a Web site as claimed. Barad discloses a method for ordering of customized toys via the Internet and a Web page. Users can log onto the web site, choose a toy and customize the toy by choosing from available features/options. Barad teaches the ordering of a custom article that was customized by the user via the Internet. Barad also discloses in the figures the well-known Hypertext Transfer Protocol, which is the standard for Internet use. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fino by providing a Web page for the selection and customization of the homes that are available for purchase. The use of HTTP necessarily follows with the modification of Fino. Barad discloses the use of the Internet and a Web page for the purchasing of an article that can be customized, and one of ordinary skill in the art would have been motivated to provide Fino with this feature. This would allow a potential customer to review and select home layouts and available options, from anywhere, and would not require them to actually visit a sales office. This would then allow the method of Fino to be available to anyone that has Internet access and results in a much more user-friendly format.

7. Applicant's arguments filed 9/26/05 have been fully considered but they are not persuasive.

Applicant's arguments with respect to recitations directed to structure of the system are directed more to the method of using the system and not the system itself. Applicant is relying upon the recitation of the fact that the communication links can link to a plurality of vendors. The prior art is fully capable of this feature and Fino discloses communication with a plurality of other offices and data sources. This satisfies what has been claimed. Applicant is arguing the intended use of the communication link for patentability, which is non-persuasive. The examiner also notes that applicant is not actually even claiming any communication with vendors in the method claims, only that the communication links of the system are for communication with vendors. The

argument is non-persuasive. The "agreements" recitation has been addressed in the rejection of record and no further comments are deemed as necessary. Also, the functional recitation that a particular design element can be provided by multiple vendors, this is a functional recitation that adds no further structure to the system because it defines nothing to the system and is not recited as an actual positive step in the method. Method step wise, the prior art is fully capable of what has been claimed because a vendor can provide design elements are claimed.

The examiner also notes that applicant has stated that the dependent claims (that have deliberately not been addressed) are believed to be patentable for limitations found in the dependent claims. Applicant then further states that if deemed necessary in the future, those arguments will be presented. The examiner dose not find this kind of statement to be in compliance with 37 CFR 1.111, which states that if applicant feels that certain limitations in any claims define over the prior art, those reasons are to be presented for the examiner to review so the case can expeditiously disposed of. In this case, applicant apparently has reasons to believe that the dependent claims are allowable over the prior art but has also apparently chosen to not present those arguments to the examiner. Because 37 CCFR 1.111 requires that applicant point out "the supposed errors" in the examiner's office action (not just some of the errors), if applicant is silent as to the rejections for the dependent claims, this is taken as applicant's acquiescence as to the merits of rejection for these claims. The rejection of all dependent claims and the 103 rejection of record are deemed to be proper because

applicant has failed to present any reasoning as to why the rejection is in error as required by 37 CFR 1.111.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER